



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|------------------------------------|------------------|
| 10/525,042 | 08/29/2005 | Harold Russell Motson | 118989-05017145 | 5681 |
| 20583 | 7590 | 01/28/2008 | | |
| JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017 | | | EXAMINER ASDJODI, MOHAMMAD REZA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1796 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 01/28/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,042

Applicant(s)

MOTSON ET AL.

Examiner

Asdjodi M. Reza

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>02/18/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

***A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.***

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Romack et al. (US 6,258,766).

Regarding Claims 1, and 7, Romack et al. teach a dry cleaning method and composition, for treating, or cleaning, textile material; [Abstract], comprising a liquid mixture of CO₂; [C.1, L63 - C.2, L.5], conditioning agent as fatty alcohols by the amount of 0.1-5%; [C.3, L.20-40].

Regarding claims 2-6, Romack et al. teach a dry cleaning method and composition comprising: C₁- C₁₅ alcohol of poly alkylene glycols and ether (oxylate), di/tri-propylene glycolether {e.g. CH₃(CH₂)₇O[CH₂CCH₃O]₂H, wherein R¹ is methyl, A is alkyleneoxy group, R² is hydrogen, and n=2}; [C.3, L.27-33].

Regarding Claim 8, Romack et al. teach a dry cleaning method and composition comprising a surfactant: [C.3, L.41-65].

Regarding claim 9, Romack et al. teach a dry cleaning method and composition comprising methyl esters; [C.4, L.1-5].

Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Romack et al. (US 6,258,766).

Regarding claim 11, Romack et al. teach a dry cleaning method and composition based on liquid CO₂ including 0.1-5% of a cleaning medium (MW≤750: see claims 2-6; [C.3, L.41]); [C.2, L.60-65], and polyalkoxylated fatty acids; [C.4, L.25-30].

Regarding Claim 12, Romack et al. teach a dry cleaning method and composition wherein cleaning medium is free of detergent surfactants wherein the dimethyl succinuat is a non detergent surfactant.

Regarding claim13, Romack et al. teach a dry cleaning method and composition comprising polyalkelengylcols and ethers; [C.3, L.15-40].

Regarding claim 14, Romack et al. teach a dry cleaning method and composition comprising methylesters or succinic acid esters; [C.4, L.1-5, 34 & C3, L.15-40].

Regarding Claim 15, Romack et al. teach a dry cleaning method and composition comprising enzymes, fragrances whiteners; [C.5, L.60-65].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Romack et al. (US 6,258,766) as applied to claim 1 and further in view of Jureller et al. (US 5,676,705).

Regarding claim 10, Romack et al. teach the basic claimed process as set forth above regarding claim 1, except the explicit teaching that the textiles are treated with conditioning medium without any cleaning additives during a rinse cycle. However, Jureller et al. teach a method of dry cleaning fabrics using carbon dioxide as only cleaning medium during a rinse cycle; [C.21, L.15-36]. Romack et al. and Jureller et al. are analogous (or combinable) art because they are from the same field of endeavour, that of dry cleaning compositions and methods utilizing liquid carbon dioxide. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use only fluid carbon dioxide for a rinse cycle, as taught by Jureller et al., in the process

of Romack et al. and would have been motivated to do so in order to wash off the residues of soil and detergent from fabrics and textile.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5 and 6 are provisionally rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 of copending application No. 10/554,781. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 corresponds to claim 1 of commonly assigned application No. 10/554,781, with the difference of the percentages of additives or conditioning agents.

Claim 2, corresponds to claim 2 of commonly assigned application No. 10/554,781, where the R¹'s are identical for the range of C₈- C₁₀.

Claim 3, corresponds to claim 3 and claim 2 of commonly assigned application No. 10/554,781.

Claim 5, corresponds to claim 2 of commonly assigned application No. 10/554,781.

Claim 6, corresponds to claim 2 of commonly assigned application No. 10/554,781.

Claims 8, 9, 11, and 12, are provisionally rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 of copending application No. 10/518,921. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 8, corresponds to claim 10 of commonly assigned application No. 10/518,921. The motivation would have been to select a multi-ester (with $MW \leq 750$) as non-surfactant cleaning agent.

Claim 9, corresponds to claim 2 of commonly assigned application No. 10/518,921.

Claims 11, and 12 corresponds to claims 1 and 10 of commonly assigned application No. 10/518,921. They overlap in scope.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Reza Asdjodi whose telephone number is 571-270-3295. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Reza Asdjodi
01/15/2008


MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER

221 Jan 08